

REMARKS/ARGUMENTS

The Applicants respectfully request further examination and consideration in view of the arguments set forth fully below. Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 were previously pending in this application. Claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 5 34-36, 40, 41, and 43-51 stand rejected under 35 U.S.C. 103(a). Accordingly, claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 43-51 are currently pending in this application.

CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)

Within the Office Action, claims 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41, and 10 43-51 are rejected under § 103(a) as being unpatentable over the article titled “Argos Business Solutions: Customer Referral Scheme Encourages Sale of Mobile Phones” (hereinafter “Argos”) in view of the article titled “recommend-it.com” (hereinafter “recommend-it”). The Applicants respectfully traverse this rejection.

The present invention is directed to a referral-based service offering and receiving a 15 reward for each specific product/service (marketable entity) purchased by a first party and a second party. A reward is offered to the first party in response to the purchase made by the first party. The reward is provided in exchange for the first party recommending the purchased marketable entity to a second party, and the second party purchasing the marketable entity. The marketable entity purchased by the second party is the same as the marketable entity purchased 20 by the first party, the antecedent basis of the claimed limitations satisfies this aspect.

The referral-based service of the present invention is implemented as part of an electronic communications network and infrastructure. For example, the first party purchases the 25 marketable entity using the network, the reward is offered to the first party using the network, the recommendation is made to the second party using email, which is enabled by the network, a Service Provider performs a purchase transaction using the network, the reward is offered to the

first party using the network, and correlating data related to the recommendation and the reward is performed using the network.

Recommend-it teaches a service whereby a first user can recommend a website to a second user. The recommendation comes in the form of an email sent by the recommend-it service to the second user. To initiate the recommendation, the first user completes a form provided by the recommend-it service. The recommendation form includes an option for the first user to receive a promotional newsletter. Although this option is presented on the same form that the first user fills out to recommend the website, the promotional newsletter is not an actual reward for making the recommendation because the promotional newsletter can be received regardless of whether the first user makes the recommendation. There is no hint, teaching, or suggestion within recommend-it that the first user makes a purchase as a prerequisite for making the recommendation. There is also no hint, teaching, or suggestion within recommend-it that the first user only receives a reward once a purchase is made by a second user, where the purchase by the second user is in response to a recommendation sent by the first user.

Argos teaches a referral program that is designed to reward customers for referring family and friends to DX Communications to purchase a new mobile phone. According to Argos “the DX Collect scheme is a chequebook-based incentive programme. Customers refer colleagues, friends or family to DX by completing a DX Collect cheque with name and address details. Customers then collect points for purchases made by the referee. Discount on DX merchandise, up to GBP 300 worth or Argos vouchers and a GBP 1,000 holiday voucher are amongst the rewards available for between 1 to 40 successful referrals. Points are stored on a special database until customers are ready to select a reward.” (Argos, page 1, paragraph 3). No other details are provided as to the implementation of this referral program. Argos provides no details as to the specific steps associated with the referral program. Argos simply teaches a first step where existing customers fill out a DX Collect cheque, and an end result where the referencing party

(Customer) collects points for purchases made by the referee. We are left to guess at the intervening steps.

The claimed invention is allowable over Argos in view of recommend-it for at least the following reasons:

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1. Within the Office Action, the Examiner asserts that Argos teaches the claimed limitation of offering a reward to the first party by the Service Provider in response to the first party purchasing the marketable entity, the reward is in exchange for a recommendation that results in a purchase of the marketable entity by a second party. The Applicants respectfully disagree with this assertion, and asserts that Argos does not teach a first party (“customer”) that purchases the same marketable entity as the second party (referee).

10 The cited Argos reference is nothing more than a press release. The press release merely provides an overview announcement of a new incentive scheme offered by DX Communications, as implemented by Argos Business Solutions. The press release does not provide means for 15 implementing the incentive scheme, such as the physical and methodological infrastructure for implementation. In particular, Argos fails to provide details as to what defines a “customer”, e.g. a referring party. The Examiner assumes that a “customer” is defined as a person that has made a purchase of a DX product or service. This is an assumption not explicitly supported within 20 Argos. Further, even if a “customer” is defined as such, Argos fails to detail what specific products or services have been purchased to deem the person a “customer”.

25 Argos specifies that the incentive scheme “is designed to reward customers for referring family and friends to DX to purchase a new mobile phone.” (Emphasis added) (Argos, page 1, paragraph 1). As such, since the customer is rewarded based on the purchase of the new mobile phone by the referred party, the “marketable entity” that is the basis of the incentive scheme is

the new mobile phone. However, the Examiner has inappropriately concluded that the “new mobile phone” purchased by the referred party, which is the product required for purchase to implement the incentive scheme, is the same “marketable entity” purchased by the original “customer” that referred the referred party, as claimed. This conclusion is not supported within 5 Argos. Argos merely teaches that “Customers refer colleagues, friends or family to DX by completing a DX Collect cheque with name and address details. Customers then collect points for purchases made by the referee.” (Argos, page 1, paragraph 3) There is no hint, teaching or suggestion within Argos that defines what purchases were made that defines a person as a “customer”. Further, the “purchases made by the referee” are specified to be the “new mobile 10 phone” on page 1, paragraph 1 of Argos. Due to the antecedent basis of the claimed “marketable entity”, the second party must purchase the same “marketable entity” as purchased by the first party in order to qualify for the reward. In order to read on the claimed limitations, Argos must at least also teach that the “customer” purchases the same “product” as the referee, which must be the new mobile phone. There is no support within Argos that indicates this to be the case. To 15 conclude that an undefined purchase (made by the “customer”) is the same as the required new mobile phone (made by the referred party) used for the incentive scheme is not founded.

2. The proposed combination of Argos in view of recommend-it is improper as the proposed combination can not be made with a reasonable expectation of success as required under 20 MPEP 2143.

It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met:

25 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

- modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
 - 3) the prior art reference, or references, must teach or suggest all the claim limitations. MPEP § 2143.
- 5 The burden of establishing a *prima facie* case of obviousness based on the teachings of Argos and recommend-it has not been met within the Office Action.

Within the Office Action, it is stated that “Argos Business Solutions doesn’t specifically teach sending the recommendation via an e-mail message to the second party comprising a personalized referral for the marketable entity including a serial number and a URL link to the 10 web site of the service provider and updating the database with the e-mail address of the second party.” This is an oversimplification of the deficiencies of Argos, as Argos is nothing more than a marketing piece that announces the introduction of a new incentive scheme offered by DX Communications, as implemented by Argos Business Solutions. There are absolutely no details related to either the conceptual implementation details or a physical infrastructure used to 15 implement this incentive scheme. The Examiner states that Argos “doesn’t specifically teach sending the recommendation via an email message.” In fact, Argos does not teach directly, or indirectly, any electronic means whatsoever for implementing the incentive scheme. There is no hint, teaching or suggestion within Argos that indicates the use of electronic means, such as an electronics communications network and infrastructure.

20 Within the Response to Arguments section, the Examiner asserts that using a communications network to perform the incentive scheme of Argos is taught in recommend-it, since recommend-it teaches using the internet for referring, rewarding and performing transactions in general. According to MPEP 2143 there must be a reasonable expectation of success. Recommend-it is cited as providing the network communication means. However, 25 there is no indication within either Argos or recommend-it as to how the incentive scheme of

Argos is to be implemented using a network communications means in general, or the internet of recommend-it. Even though recommend-it teaches network communication means, there is no teaching as to an incentive scheme implemented by the recommend-it network communication means. The Examiner states that it is merely a manner of applying a network communications means, such as in the cited recommend-it, to the incentive scheme of Argos. However, the Examiner provides no means by which this can be accomplished. The Applicants fail to see how the details of an incentive scheme can be implemented electronically, using a network communication means, when the details of the incentive scheme itself are not provided (Argos provides insufficient implementation details to enable an electronics implementation). Not only would implementation details of the incentive scheme itself need to be guessed at (since Argos does not provide them in sufficient detail), but the means for implementing such guessed details would also have to be determined, especially in the added context of an electronics communication network. As neither Argos nor recommend-it provide such details, the burden would fall to experimentation on the part of the implementor. Such undue experimentation negates the obviousness of such a combination, and supports the position that the proposed combination of Argos in view of recommend-it does not have a reasonable expectation of success. Therefore, the proposed combination of Argos in view of recommend-it is not proper.

3. The proposed combination of Argos in view of recommend-it does not teach offering a reward via an electronics communication network and infrastructure.

As described in point 3 above, the Examiner asserts that using a communications network to perform the incentive scheme of Argos is taught in recommend-it, since recommend-it teaches using the internet for referring, rewarding and performing transactions in general. As acknowledged by the Examiner, recommend-it teaches “general” functionality. However, such

“general” functionality is not sufficient to provide the specific implementation of the incentive scheme of Argos. Further, the Examiner has previously acknowledged that recommend-it does not teach a reward for recommending (See Office Action with mail date of January 25, 2008; Response to Arguments section, item 6), which is why MileNet was previously cited. The
5 Examiner now contends that recommend-it does teach “the internet for ... rewarding” as justification for applying the electronic network communications infrastructure of recommend-it to Argos, clearly a contradiction which can not now be used as support for the proposed combination, or for support of the assertion that recommend-it teaches offering a reward via an electronics communication network and infrastructure.

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4. The proposed combination of Argos in view of recommend-it is improper due to hindsight of the present invention.

15 Within the Response to Arguments section, the Examiner states that Argos is specifically cited to teach providing an offer (points) to the first user if a second user becomes a member of DX Communications and purchases a telephone, and the recommend-it was “merely cited to teach the general concept of sending an e-mail containing recommendation in the form of a URL.” However, the Applicants again point out that Argos fails to teach any means for applying a network communication infrastructure to implement the incentive scheme. The Examiner
20 explicitly acknowledges this fact (Office Action, page 4, middle paragraph). It is only through hindsight of the present invention that the Examiner is able to apply an electronic communication network to a methodology not originally designed to be electronically implemented. Accordingly, the proposed combination is again improper.

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For at least the four reasons detailed above, the combination of Argos and recommend-it fail to teach the claimed limitations as included in the independent claims 1, 46, and 50. Claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41, and 43-45 depend from independent claim 1. Claims 47-49 depend from the independent claim 46. Claim 51 depends from the independent 5 claim 50. Because the dependent claims 2-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40-41, 43-45, 47-49, and 51 are dependent on allowable base claims, they are also allowable.

Additional Allowable Subject Matter

The Applicants previously argued the allowable aspects of the dependent claims 8 and 9. 10 However, the Examiner failed to address these arguments in the Office Action. Those arguments are repeated below.

Dependent claim 8 includes “wherein the step of forwarding the first e-mail message to the second party comprises the steps of (a.) forwarding the first e-mail message from the first party to the second party, and (b.) forwarding an authenticating e-mail message from the first 15 party to a provider of the first Web site, the authenticating e-mail message comprising a first serial number and the e-mail address of the second party, the authenticating e-mail message thereby enabling the second party to access the first Web site and transact for the marketable entity.” Recommend-it specifically teaches forwarding the first email message from the recommend-it service to the second party (Recommend-it, page 2, left frame lines 1-4). 20 Recommend-it does not teach forwarding the first email message from the first party to the second party, as claimed in claim 8.

Dependent claim 9 includes “wherein the step of forwarding the first e-mail message to the second party and the step of forwarding the authenticating e-mail message to the provider are performed as the result of a single mail command initiated by the first party.” As stated above in 25 regard to claim 8, recommend-it specifically teaches forwarding the first email message from the

recommend-it service to the second party. Recommend-it does not teach forwarding the first email message from the first party to the second party, and also forwarding an authenticating email from the first party to the provider as a result of a single mail command initiated by the first party, as claimed in claim 9.

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Final Status of Office Action

Within the Office Action, the action is made final. The Applicants respectfully contend that making the action final is inappropriate as the Examiner has failed to clearly state the reasons in support thereof, inhibiting the Applicants from readily judging the advisability of an appeal. According to 37 CFR 1.113 directed to Final rejection or action, “(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.” (Emphasis added). MPEP 706.07 includes “In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.” (Emphasis added).

Regarding dependent claims 8 and 9, the Examiner fails to provide reasons for rejecting these claims. The Applicants have repeatedly requested examination of these dependent claims, but those requests have not been recognized. As such, the Applicants have no clear grounds to judge the advisability of an appeal, and the Office Action should be made non-final.

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Attorney Docket No.: DERN-00101

In view of the foregoing, Applicants believe all claims now pending in this application
are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is
respectfully requested. If the Examiner believes that a telephone conference would expedite
prosecution of this application, the Examiner is encouraged to contact the undersigned at (408)
5 530-9700.

Respectfully submitted,

HAVERSTOCK & OWENS LLP

10 Dated: September 30, 2009 By: /Thomas B. Haverstock/
Thomas B. Haverstock
Reg. No. 32,571
Attorneys for Applicant